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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
(OAKLAND DIVISION)

FINJAN LLC,

Plaintiff,

v.

PALO ALTO NETWORKS, INC.,

Defendant.

Case No. 14-cv-04908-PJH

**FINJAN LLC'S RESPONSE IN
OPPOSITION TO PALO ALTO
NETWORKS, INC.'S ADMINISTRATIVE
MOTION FOR LEAVE TO INCLUDE
ADDITIONAL CLAIM TERMS IN THE
JOINT CLAIM CONSTRUCTION
STATEMENT**

Hon. Phyllis J. Hamilton
Ctmm: 3, 3rd Floor

1 The Court should deny Palo Alto Networks, Inc.’s (“PAN”) request to include up to 24
 2 terms¹ in the parties’ upcoming Joint Claim Construction Statement (“JCCS”). Finjan’s position is
 3 that only two terms require construction at this time. PAN alone proposes that an additional 22
 4 terms require construction, more than double the number permitted by this Court’s Standing Order.
 5 As explained below, PAN falls far short of demonstrating the required good cause. While PAN
 6 argues that courts have construed terms in these patents before, PAN fails to note that those courts
 7 have rejected the construction PAN has proposed for five of the 22 terms, and that no court has
 8 adopted another eleven of PAN’s proposed constructions. PAN’s proposal is also speculative and
 9 unnecessary, as PAN admits it does not know whether many of the purported claim construction
 10 disputes “will be relevant.” (Mot. at p. 2 (“at this point it is not certain whether those disputes will
 11 be relevant to the trier of fact”).) The Court need not permit such speculation. This case has
 12 narrowed significantly; the parties can work together to identify the ten most significant terms in
 13 the four remaining patents,² and the Court need not construe more than those ten terms.

14 No court in this District has needed to construe more than ten terms in the first round of
 15 claim construction in any Finjan case—even in cases with more than four asserted patents—with
 16 the lone exception of the *Symantec* case. In *Symantec*, which involved eight asserted patents, the
 17 court construed twelve terms, but then found no construction necessary for seven of the twelve,
 18 including two terms (the preamble and the “content processor” terms from the ’154 Patent) for which
 19 PAN has proposed a construction here. PAN’s current proposal requests construction of essentially
 20 every term that has ever been construed in any proceeding (district court or PTAB), plus several
 21 other terms that have never been construed. This presents an unnecessary strain on resources for
 22 the Court and Finjan, especially where PAN fails to identify why any specific term over the ten-
 23 term limit would be material to the case. The Court should deny PAN the requested relief.

24 PAN has not provided the required “good cause” for exceeding the Court’s ten-term limit
 25 for several reasons. Although PAN argues that 12 of its 22 proposed constructions “arise from prior

26
 27 ¹ PAN argues it wants to submit up to 21 terms, but PAN improperly groups multiple terms in its
 exchanges, and Finjan has objected to this grouping.

28 ² Pursuant to the Court’s Order, the parties are working together to submit an updated stipulation
 and proposed order to dismiss the ’494, ’780, and ’926 Patents. (Dkt. No. 131 at p. 2.)

claim construction” (Mot. at p. 1), that statement is misleading. For **16** of its 22 terms, PAN’s proposed construction has never been adopted by any court or the PTAB. Those 16 terms fall into three categories.

First, **five** of PAN’s proposed constructions have already been rejected by other courts:

- “transmitter” (’154 Patent, claim 1): PAN’s proposed construction was rejected by Judge Gonzalez Rogers. (See Dkt. No. 118 at p. 11.)
- “receiver” (’154 Patent, claim 1): PAN’s proposed construction was rejected by Judge Gonzalez Rogers. (See Dkt. No. 118 at p. 11.)
- “dynamically-generated” (’154 Patent, claim 1): No construction necessary for preamble in *Symantec*, IPR2015-01547 and IPR2016-00151. (See Dkt. No. 118 at p. 9.)
- “second function” (’154 Patent, claim 1): No court has construed that term in isolation as anything other than plain meaning. (See Dkt. No. 118 at p. 10.)
- Preamble of claim 14 (’633 Patent, claim 14): All previous courts have corrected the typographical error and found the claim not indefinite. (See Dkt. No. 118 at p. 9.)

PAN argues that “prior constructions represent significant investments by courts, the PTAB, and previous litigants in clarifying the scope and meaning of the asserted claims.” (Mot. at p. 1.) Yet PAN throws this all out the window with its proposal.

Second, another **six** of PAN’s proposed constructions are for terms that have never been construed by any court, including multiple terms that are plain English with a well-understood meaning such as “safe” and “scanner.”³ These terms need no construction and there is no need to make an exception to the Rules here to construe them.

Third, another **five** of PAN’s proposed constructions are new proposals for terms that have been construed, but have never been adopted by any tribunal. PAN’s proposed constructions either

³ The term “scanner” has been construed in the context of the ’408 Patent, but not the ’731 Patent. The proposed construction for the ’408 Patent in the *Rapid7* case was also different from what PAN now proposes for both patents here.

1 add words that are not present in the claims or raise entirely new issues that are unsupported by the
2 intrinsic record of the patents.

3 That leaves only six of the 22 terms as being ones for which PAN has proposed a
4 construction that a previous court has adopted. But even for those six terms, different courts have
5 generally come to different conclusions, and in most instances at least one court has adopted the
6 competing construction proposed by Finjan. All of this is to say, Finjan is not complicating things
7 by not agreeing to well-established constructions as PAN seems to assert; instead, PAN is
8 complicating things by trying to maintain as many disputes as possible in hopes something will
9 become relevant.

10 PAN also fails to show good cause because the requested relief is speculative and undefined.
11 The law in this District requires PAN to specifically explain why it is necessary to deviate from the
12 Patent Local Rules. *See, e.g., Sage Electrochromics, Inc. v. View, Inc.*, No. 12-cv-6441-JST, 2014
13 WL 1379282, at *3 n.2, 4 (N.D. Cal. Apr. 7, 2014) (finding it a “special situation” when the Court
14 construes more than 10 claim terms: “[i]f the parties believe the Court should deviate from their
15 usual rule of construing not more than ten total terms, they should explain why.”). PAN does not
16 explain why this Court should deviate from the Patent Local Rules and its Standing Order. For
17 example, PAN argues that “[i]nclusion will not burden the Court with additional work at this time.”
18 (Mot. at p. 2.) PAN seems to be arguing that the parties need to provide more than ten terms for
19 construction in the JCCS, even though they do not presently need to brief more than ten terms.
20 Indeed, PAN admits that, “at this point it is not certain whether these disputes will be relevant to the
21 trier of fact.” This should end the inquiry—there is presently no need to construe more than ten
22 terms. If there is no present need to brief more than ten terms, then the parties need not present
23 more than ten terms to the Court in the JCCS.

24 Indeed, in *Finjan v. Cisco*, Judge Freeman denied Cisco’s motion in the first round of claim
25 construction to construe ten additional claim terms where five patents were at issue. Judge Freeman
26 noted that Cisco had “not shown that it would be prejudiced if the Court denies its request to brief
27 additional claim terms.” *See Finjan, Inc. v. Cisco Sys., Inc.*, No. 17-cv-00072-BLF, Dkt. No. 92
28 (Order Denying Without Prejudice Administrative Motion to Brief More Than Ten Claim Terms

1 For Construction) (Dec. 11, 2017). The same is true here. PAN has not attempted to show any
2 prejudice, and indeed is unsure if any of these additional terms would even be relevant. Judge
3 Freeman also noted that “courts have routinely declined to deviate from the Patent Local Rules
4 which set a default ten-term limit even in cases where more than five patents and thirty claims were
5 asserted,” and that “the ten-term limit serves as a reasonable and effective case management tool.”
6 *Id.*

7 Also PAN argues that, “for each of the terms in excess of the ten-term limit, PAN relies on
8 either previously settled constructions, portions of settled constructions, or previous positions taken
9 by Finjan in other proceedings.” (Mot. at p. 2.) It is unclear how PAN could make this
10 representation when the parties have not yet completed their meet and confer process and have not
11 identified the ten most significant terms. Without knowing the ten most significant terms, PAN
12 cannot say it knows which terms are “in excess of the ten-term limit.”

13 PAN also argues that including the additional terms in the JCCS will “eliminate
14 gamesmanship” and “crystallize the parties’ positions on claim construction.” (Mot. at p. 2.) These
15 are not good cause justifications for deviating from the Rules, and PAN cites no authority saying
16 otherwise. Finjan’s positions are clear as to all terms. Finjan does not believe any but **two** terms
17 require construction at this point, and it is PAN that wants to construe more than double the limit
18 imposed by this Court. That request should be denied.

19 Finally, Finjan has worked hard to narrow this case significantly, obviating the need to
20 construe more than ten terms. In the four months since the Case Management Conference, Finjan
21 has reduced this case from ten patents and over 70 claims to just four patents and 21 claims. Ten
22 terms is more than sufficient for PAN to construe the most significant terms and the limit serves as
23 an effective case management tool.

24 Accordingly, the Court should deny PAN’s request for leave to include more than ten terms
25 in the JCCS, and the parties should continue towards construction of up to ten terms as contemplated
26 by the Patent Local Rules and this Court’s Standing Order.

1 Dated: July 6, 2021

Respectfully Submitted,

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